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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/476,319	12/30/1999	TAKAYUKI HASEBE	P21-9028	7660

32294 7590 03/31/2003

SQUIRE, SANDERS & DEMPSEY L.L.P.  
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8000 TOWERS CRESCENT  
TYSONS CORNER, VA 22182

EXAMINER

BARRON JR, GILBERTO

ART UNIT PAPER NUMBER

2132

DATE MAILED: 03/31/2003

30

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/476,319

Applicant(s)

HASEBE ET AL.

Examiner

Gilberto Barrón Jr.

Art Unit

2132

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 04 March 2003.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-56 and 111-125 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-56 and 111-125 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☒ Certified copies of the priority documents have been received in Application No. 08/031,339.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                             | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____                                    |

***Reissue Applications***

1. The Response filed March 4, 2003 has been carefully considered and the following results are noted. The amendment to the claims has overcome the grounds of rejection based on 35 USC §251 (Recapture and Not Original Invention) and 35 USC §112 (Indefinite claim language). However, the arguments in traverse of the grounds of rejection based on non-statutory subject matter 35 USC § 101 are not persuasive.

***Response to Arguments***

2. Applicant's arguments to the effect that the pending claims are statutory subject matter since they recite functional relationships between the areas of the storage medium that are recited in the various claims, and/or the storage medium and the user computer, which places the claims in compliance with 35 USC § 101. Applicant argues that this recitation clearly recites the practical application of decryption of encrypted data, and/or enabling access to a storage area by a computer.

3. The argument that the claims recite functional relationships between the areas of the storage medium is not persuasive because the description of the relationship between the different storage areas of the storage medium is not itself functional. The description of the relationship between the storage areas of the storage medium is an abstract idea and not a functional one where the data from one storage area may cause a computer to perform a stated functionality on other data in a different storage area. The claimed storage medium is presented as comprised solely of data: data representing a medium personal number, encrypted electronic data and data representing permission information. There is no recitation of data that is functional in

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nature so as to cause a computer to perform or execute a particular operation that results in a practical application. The data that is recited is merely data to be processed. However, this data is itself not the cause or descriptive functional subject matter by which a computer is transformed in to a specific machine.

4. MPEP 2106, section II, (a) states: Apart from the utility requirement of 35 U.S.C. 101, usefulness under the patent eligibility standard requires significant functionality to be present to satisfy the useful result aspect of the practical application requirement. See *Arrhythmia*, 958 F.2d at 1057, 22 USPQ2d at 1036. Merely claiming nonfunctional descriptive material stored in a computer-readable medium does not make the invention eligible for patenting. For example, a claim directed to a word processing file stored on a disk may satisfy the utility requirement of 35 U.S.C. 101 since the information stored may have some "real world" value. However, the mere fact that the claim may satisfy the utility requirement of 35 U.S.C. 101 does not mean that a useful result is achieved under the practical application requirement. The claimed invention as a whole must produce a "useful, concrete and tangible" result to have a practical application.

5. The claims at issue only provide for non-functional descriptive matter that is data that may be encrypted (encrypted electronic data), or used to generate an encryption key (medium personal number), or data representing permission information. These various data may have a conceptual or abstract relationship of one to another but do not provide for descriptive matter that would impart functionality to a computer or cause a computer to perform a described function.

6. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action. The following is a re-presentation of the grounds of rejection remaining to be resolved.

***Claim Rejections - 35 USC § 101***

7. Claims 1-56 and 111-125 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The instant claims are directed to non-functional descriptive matter. Non-functional descriptive matter is that which exhibits no functional interrelationship, either as part of the stored data or as part of the computing processes performed by the computer, then such descriptive material alone does not impart functionality either to the data as so structured, or to the computer. Such "descriptive material" is not a process, machine, manufacture or composition of matter. The instant claims recite a storage medium with two or three storage areas. However, none of the storage areas provide for descriptive matter that provides for a functionality either to the data as structured or a process to be implemented on a computer. The claims seek to patent a storage medium that is a repository for specific type data, but that data is not functional in nature. The data on the storage medium is solely to be acted on by another process when imparted to a computer.

The original patent application 08/603,760 amended the pending claims by adding to the preamble "accessed by a vendor computer and user computer, said storage medium" ...."information readable by said user computer, said storage medium" to overcome the 101 non-statutory rejection raised at that time. However, it is not clear

that the claims of this reissue application provide for functional descriptive matter, either with claims that still retain the preamble that was originally amended or with the newly added claims that do not have the amendatory language.

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gilberto Barrón Jr. whose telephone number is (703) 305-1830. The examiner can normally be reached on Mondays thru Thursdays from 8:00 AM to 5:00 PM. The examiner can also be reached on alternate Fridays.


If attempts to reach the examiner by telephone are unsuccessful, Mr. Albert Decady, who can be reached on (703) 305-9595, or Ms. Gail Hayes, who can be reached on (703) 305-9711, may be contacted for assistance.

The fax phone number for OFFICIAL responses for the organization where this application or proceeding is assigned is (703) 746-7239.

The fax phone number for AFTER FINAL responses for the organization where this application or proceeding is assigned is (703) 746-7238.

The fax phone number for DRAFT proposals for the organization where this application or proceeding is assigned is (703) 746-7240

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

  
GILBERTO BARRÓN  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2100